

## REMARKS

Claims 30-51 are currently pending in the application. Claims 30, 38, 40 and 49 have been amended. New claims 50 and 51 have been added.

### **THE PRESENT INVENTION**

The pending application discloses several embodiments and the pending claims are directed to one of those embodiments – the “pick-and-solve” feature. To clarify the Applicants’ invention, the Applicants respectfully direct the Examiner’s attention to FIGS. 13-18 and the corresponding portion of the specification which describes this feature.

As shown in FIGS. 13 and 14, this “pick-and-solve” feature of the gaming machine includes displaying a plurality of selectable elements (FIG. 14) and a plurality of groups of objects (FIG. 13). Each time the player selects a single selectable element (*e.g.*, one bee character), an indicia (*e.g.*, a letter of the alphabet), which is initially concealed under the selectable element, is revealed. Then, any letters within the groups that correspond to the selected element are identified in the plurality of groups of objects. For example, in FIG. 15, four selectable elements (*e.g.*, bee characters) have been sequentially selected and the corresponding indicia (*e.g.*, the letters “R,” “T,” “A,” and “C”) were sequentially revealed. After each selection, as shown in FIG. 16, the objects in the plurality of groups associated with the selected elements are identified. As shown in FIG. 18, all of the objects associated with one group (the word “fruit”) are eventually identified and an award, which in this case is a bonus of 100 credits, is awarded.

As the Examiner is aware, this is markedly different from the applied reference of **Helm**. Applicant’s have amended the claims to more clearly distinguish the claims from the disclosure of **Helm** to expedite prosecution. Reconsideration and allowance of the pending claims is respectfully requested.

### **1. THE 35 U.S.C. § 102 REJECTION**

Claims 30-33, 35-43 and 45-49 are being rejected under 35 U.S.C. § 102(b) as being anticipated by Helm et al. (U.S. 4,743,024). Reconsideration is requested.

The Applicants respectfully submit that the claims, as amended, are not anticipated by **Helm** under 35 U.S.C. § 102(b) and are patentable thereover.

**Helm** does not disclose or suggest a gaming machine comprising at least one display displaying a plurality of groups of objects and a plurality of player-selectable elements separate from the plurality of groups of objects, each of the plurality of player-selectable elements being simultaneously displayed and initially concealing indicia indicative of all of the objects within the plurality of groups of objects, nor does it disclose an input device for receiving from a player sequential selections of said simultaneously displayed player-selectable elements, as recited in claim 30. Even under the Examiner's reading of **Helm**, with which Applicant's take issue and do not adopt, **Helm** cannot reasonably be said to teach or suggest that each of the plurality of player-selectable elements are simultaneously displayed.

**Helm** does not disclose or suggest a gaming machine comprising at least one display displaying a plurality of groups of objects and a plurality of player-selectable elements separate from the plurality of groups of objects, the plurality of player-selectable elements being simultaneously displayed in an array and initially concealing indicia indicative of the objects within the plurality of groups of objects, at least some of the plurality of selectable elements concealing indicia that can be indicative of any object within any of the plurality of groups, as recited in claim 40. **Helm** also fails to disclose or suggest an input device for receiving from a player sequential selections of the player-selectable elements from the displayed array of player-selectable elements, as recited in claim 40. **Helm** discloses reels 22, 24 bearing numbers which may be stopped (e.g., via "skill spin" buttons 26, 28, 30) randomly to reveal a pair of numbers corresponding to a pair of numbers on a bingo display. The possible combinations of numbers on the reels 22, 24 are not simultaneously displayed in an array for selection by the player and **Helm** does not provide an input device for receiving from a player sequential selections of the player-selectable elements from the displayed array of player-selectable elements.

As to claim 49, **Helm** does not disclose or suggest a gaming machine configured to conduct a basic game and a bonus game, comprising at least one display displaying, in the bonus game, a plurality of groups of objects and a plurality of player-selectable elements separate from

the plurality of groups of objects, the plurality of player-selectable elements being displayed in an array and initially concealing indicia indicative of the objects within the plurality of groups of objects. **Helm** also fails to disclose or suggest claim 49's input device comprising a touch screen for receiving from a player sequential selections of the player-selectable elements from the displayed array of player-selectable elements.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). In view of the above remarks and accompanying amendments, it is respectfully submitted that **Helm** does not identically teach, expressly or inherently, each and every element as set forth in the claims. Reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejection is requested.

## 2. THE 35 U.S.C. § 103 REJECTION

Claims 34, 36, 44 and 46 are being rejected under 35 U.S.C. § 103(a) as being unpatentable over **Helm**. Reconsideration is requested.

As an initial matter, **Helm** does not teach or suggest the elements noted above in the remarks responsive to the 35 U.S.C. § 102(b) rejection, which are incorporated herein, but are omitted for brevity.

As to the additional allegations set forth in the 35 U.S.C. § 103(a) rejection, the Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated into **Helm** the "touch screen positioned over said display" (claims 34, 44) or the gaming machine which "conducts a basic game and a bonus game, said plurality of groups of objects and said plurality of player-selectable elements being associated with said bonus game" (claims 36, 46).

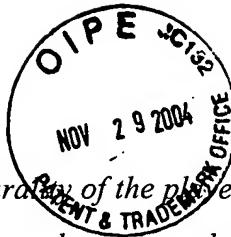
**Helm** does not teach or suggest a touch screen. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). The legal concept of *prima facie* obviousness is a

procedural tool of patent examination, allocating the burdens of going forward with production of evidence in each step of the examination process (*citations omitted*)(see, e.g., MPEP § 2142). The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness. Accordingly, reconsideration and withdrawal of the rejection of claims 34 and 44 is requested for at least this reason.

**Helm** also fails to teach or suggest that the asserted “plurality of groups of objects” and “plurality of player-selectable elements” (see, e.g., pages 2-3 of the Office Action) would be obviously associated with a bonus game by one of ordinary skill in the art at the time of the invention. Instead, **Helm** teaches that the alleged “player-selectable elements” (i.e., reels 22, 24 under the Examiner’s interpretation of **Helm**) form an intrinsic part of the base game. The random number display assembly which includes reels 22, 24 displays, upon a pull of handle 16, a number which corresponds to one of the numbers in the matrix 15. If the alleged “player-selectable elements” were associated with a bonus game rather than the game disclosed in **Helm**, such modification would render **Helm** unsatisfactory for its intended purpose. “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)(emphasis added). Further, such modification would change the principle of operation of **Helm**, which premises game play on the presence of the asserted “player-selectable elements” (22, 24). “If a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious.” *In re Ratti*, 270 F.2d 810 (CCPA 1959).

### 3. THE NEW INDEPENDENT CLAIM 51

New claim 51 is submitted to be patentable over **Helm**, as it requires, *inter alia*, a processor in communication with the display and the input device, in response to each of the sequential selections received from the input device, the processor instructing the display to reveal each of the objects associated with the selected one of the plurality of the player-selectable



elements and to remove the selected one of the plurality of the player-selectable elements from a population of player-selectable elements to prevent subsequent selection of said selected one of said plurality of said player-selectable elements. **Helm** does not teach or suggest this feature.

#### CONCLUSION


It is the Applicant's belief that all of the claims are patentable and are in condition for allowance, and action towards that end is respectfully requested.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47079-00055USC2.

Respectfully submitted,

November 24, 2004  
Date

  
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